

TRANSMITTAL LETTER

Inventor: Kurt Berlin
Serial No: 10/048,182
Filed: July 27, 2000

Examiner: Unknown
Group Art Unit: Unknown
Confirmation No: 2914

For: METHOD FOR CHARACTERIZING NUCLEIC ACID FRAGMENTS

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

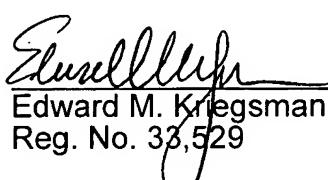
Transmitted herewith for the above-identified patent application are the following:

A Request under 37 CFR 1.8(b) for Withdrawal of Holding of Abandonment
A copy of Notice of Abandonment filed March 1, 2004
A copy of papers filed May 28, 2002
A postcard

The item(s) checked below are appropriate:

1. Applicant(s) hereby petition(s) for a () month extension of time to respond to a
1755. 2. Please charge any fees or costs not accounted for to Deposit Account No. 11-
3. Applicant is a small entity.

Date: March 16, 2004


Edward M. Kriegsman
Reg. No. 33,529

KRIEGSMAN & KRIEGSMAN
665 Franklin Street
Framingham, MA 01702
(508) 879-3500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 16, 2004.


Edward M. Kriegsman

PATENT
Attorney Docket No. 81801
Customer No. 23685

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
KURT BERLIN)
Serial No.: 10/048,182) Group Art Unit: Unknown
I.A. Filed: July 27, 2000) Examiner: Unknown
For: METHOD FOR CHARACTERIZING NUCLEIC ACID) Confirmation No.: 2914
FRAGMENTS)

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST UNDER 37 CFR 1.8(b) FOR WITHDRAWAL
OF HOLDING OF ABANDONMENT

Pursuant to 37 CFR 1.8(b), Applicant hereby respectfully requests withdrawal of the holding of abandonment of the above-identified patent application.

A Notice of Abandonment under 37 CFR 1.53(f) or (g) was mailed by the Patent Office on March 1, 2004, for the subject application, and a copy of said Notice of Abandonment is enclosed herewith. In said Notice of Abandonment, the Patent Office states that "[n]o reply was received" to the Notice to File Missing Parts mailed on April 3, 2002.

Applicant hereby informs the Patent Office that a reply to said Notice to File Missing Parts (said Notice to File Missing Parts actually being entitled a "Notification of Missing Requirements")

was, in fact, filed by Applicant on May 28, 2002. A copy of said reply is enclosed herewith, said reply including a transmittal letter, a copy of the Notification of Missing Requirements, a Declaration, a check for \$65, and an English translation of the International Preliminary Examination Report. As can be seen, the transmittal letter of said reply contains a certificate of mailing signed by the undersigned and dated May 28, 2002.

Applicant first became aware that the Patent Office had not received Applicant's reply to the Notification of Missing Requirements upon receiving the aforementioned Notice of Abandonment dated March 1, 2004. The present request is being made promptly after Applicant first became aware that the Patent Office has no evidence of receipt of Applicant's reply.

The undersigned hereby states on personal knowledge that the above-mentioned reply was mailed in accordance with 37 CFR 1.8 on May 28, 2002; therefore, the reply was timely mailed.

Please proceed with the prosecution of this application on the basis of the attached copy of the papers originally transmitted.

Acknowledgment of the active status of this application is respectfully requested.

If, for some reason, the present request is lacking in some respect, Applicant respectfully requests that the Patent Office contact the undersigned, preferably by telephone, so that any outstanding requirements may be met.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Kriegsman & Kriegsman

By: Edward M. Kriegsman

Edward M. Kriegsman
Reg. No. 33,529
665 Franklin Street
Framingham, MA 01702
(508) 879-3500

Dated: March 16, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 16, 2004

Edward M. Kriegsman
Edward M. Kriegsman
Reg. No. 33,529
Dated: March 16, 2004



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/048,182		Kurt Berlin	81801

CONFIRMATION NO. 2914
 ABANDONMENT/TERMINATION
 LETTER



OC000000011990768

Date Mailed: 03/01/2004

NOTICE OF ABANDONMENT UNDER 37 CFR 1.53 (f) OR (g)

The above-identified application is abandoned for failure to timely or properly reply to the Notice to File Missing Parts (Notice) mailed on 04/03/2002.

- No reply was received.

A petition to the Commissioner under 37 CFR 1.137 may be filed requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(l); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Any questions concerning petitions to revive should be directed to the "Office of Petitions" at (703) 305-9282. Petitions should be mailed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

*A copy of this notice **MUST** be returned with the reply.*

KRIEGSMAN & KRIEGSMAN
ATTORNEYS AT LAW
665 FRANKLIN STREET
FRAMINGHAM, MA 01702

USSN

10/048,182

5-7515/110

2219

PAY SIXTY-FIVE and 00/00

DOLLARS

CHECK NO.	TO THE ORDER OF	DATE	CHECK AMOUNT
2219	COMMISSIONER OF PATENTS & TRADEMARKS 5-28-02		\$65.00
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Sovereign
SOVEREIGN BANK NEW ENGLAND

Daniel S. Kriegsman

Received in the U.S. Patent and Trademark Office in re:

Applicant: Kurt Berlin

Serial No: 10/048,182

I.A. Filing Date: 7-27-00

For: METHOD FOR CHARACTERIZING NUCLEIC
ACID FRAGMENTS

Included are:

A Notification of Missing Requirements

A Declaration and Power of Attorney

A check for \$65

English Translation of International Preliminary
Examination Report

A Transmittal letter

81801

5-28-02

Patent Attorney
Docket No 81801

TRANSMITTAL LETTER

Inventors: Kurt Berlin
Serial No: 10/048,182
I.A. Filing Date: 7-27-00
Notice of Allowance:
For: METHOD FOR CH

Group Art Unit: Unknown
Examiner: Unknown
Confirmation No:

For: METHOD FOR CHARACTERIZING NUCLEIC ACID FRAGMENTS

**Box Missing Parts
Commissioner for Patents
Washington, D. C. 20231**

Dear Sir:

Transmitted herewith for the above-identified patent application are the following:

- A Notification of Missing Requirements
- A Declaration and Power of Attorney
- A check for \$65
- English Translation of International Preliminary Examination Report
- A return postcard

The item(s) checked below are appropriate:

an 1. Applicant(s) hereby petition(s) for a () month extension of time to respond to
dated .

1755. 2. Please charge any fees or costs not accounted for to Deposit Account No. 11-
3. Applicant is a small entity.

Date: May 28, 2002

Ellelehr
Edward M. Kriegsman
Reg. No. 33,529

KRIEGSMAN & KRIEGSMAN
665 Franklin Street
Framingham, MA 01702
(508) 879-3500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Missing Parts, Commissioner for Patents, Washington, D. C. 20231 on May 28, 2002.

Edward M. Kriegsman

PATENT COOPERATION TREATY

77

Translation

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference P01/1116/WO	FOR FURTHER ACTION SeeNotificationofTransmittalofInternationalPreliminary ExaminationReport(FormPCT/IPEA/416)	
International application No. PCT/DE00/02595	International filing date (day/month/year) 27 July 2000 (27.07.00)	Priority date (day/month/year) 28 July 1999 (28.07.99)
International Patent Classification (IPC) or national classification and IPC C12Q 1/68		
Applicant EPIGENOMICS AG		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 7 sheets, including this cover sheet.

This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of _____ sheets.

3. This report contains indications relating to the following items:

- I Basis of the report
- II Priority
- III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

Date of submission of the demand 19 February 2001 (19.02.01)	Date of completion of this report 23 November 2001 (23.11.2001)
Name and mailing address of the IPEA/EP	Authorized officer
Faxsimile No.	Telephone No

International application No.

PCT/DE00/02595

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

I. Basis of the report

1. With regard to the elements of the international application:^{*} the international application as originally filed the description:

pages _____ 1-27 _____, as originally filed

pages _____ filed with the demand

pages _____, filed with the letter of _____

 the claims:

pages _____ 1-19 _____, as originally filed

pages _____, as amended (together with any statement under Article 19)

pages _____, filed with the demand

pages _____, filed with the letter of _____

 the drawings:

pages _____, as originally filed

pages _____, filed with the demand

pages _____, filed with the letter of _____

 the sequence listing part of the description:

pages _____, as originally filed

pages _____, filed with the demand

pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item. These elements were available or furnished to this Authority in the following language: _____ which is:

 the language of a translation furnished for the purposes of international search (under Rule 23.1(b)). the language of publication of the international application (under Rule 48.3(b)). the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

 contained in the international application in written form. filed together with the international application in computer readable form. furnished subsequently to this Authority in written form. furnished subsequently to this Authority in computer readable form. The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished. The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.4. The amendments have resulted in the cancellation of: the description, pages _____ the claims, Nos. _____ the drawings, sheets/fig. _____5. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).^{**}

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/DE00/02595

II. Priority

1. This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:

copy of the earlier application whose priority has been claimed

translation of the earlier application whose priority has been claimed.

2. This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid.

Thus for the purposes of this report, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

SEE SEPARATE SHEET

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/DE 00/02595

1. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

1. The sheet with sequence protocols filed with the communication dated 29 January 2000 is not part of the application (PCT Rule 13th.1(f)).

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/DE 00/02595

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: I I

1. The priority (28 July 1999) of the present application was examined and found to be valid.

International application No.
PCT/DE 00/02595

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-18	YES
	Claims	19	NO
Inventive step (IS)	Claims	1-18	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-19	YES
	Claims		NO

2. Citations and explanations

1. General

Reference is made to the following document:

D1: WO 99 28498 (OLEK ALEXANDER; WALTER JOERN (DE); EPIGENOMICS GMBH (DE); OLEK SVE) 10 June 1999 (1999-06-10)

2. Novelty

2.1 Claim 19 refers to a kit comprising reagents. This is a typical and commonly known feature of a kit (for example D1, Claim 22) and therefore Claim 19 is not novel (PCT Article 33(2)).

3. Inventive step

3.1 Claim 1 seems to be inventive (PCT Article 33(3)) since none of the documents cited in the search report discloses a method or contains suggestion thereof covering an array of reversibly immobilized oligomers and a support element to which the test nucleic acid is connected, as stated in Claim 1. Claims 2 - 18 which are dependent on Claim 1 are therefore also inventive (PCT Article 33(3)).

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/DE 00/02595

4. Industrial applicability

4.1 The claims of the present patent application refer to subject matter that appears to meet the criterion of industrial applicability (PCT Article 33(1)(4)).

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/DE 00/02595

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of VI

1. The following document has an earlier priority and filing date than the present application. The subject matter of this document may be relevant to the examination of the present application in the regional or national phase.

D1: WO-A-00 04372

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/DE 00/02595

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made.

1. Claim 1 lacks clarity (PCT Article 6) with respect to the nucleic acid fragment immobilized on a surface. It is not clear for example whether the nucleic acid fragment is also disposed in the form of a grid on the surface and whether there is any relationship between the size and the grid of this surface and the oligomer array and if so, what. This information appears to be essential for the functioning of the disclosed method. The exact meaning of the term "nucleic acid fragment" is also not clear (PCT Article 6).
2. Step c) in Claim 1 is defined only by the result to be achieved, which is not admissible (PCT Guidelines, Section IV, Chapter III-4.7). In accordance with the description, only one embodiment seems to be disclosed, i.e. the formation of "cavities" (page 18, line 28).
3. Claim 18 is defined only by the result to be achieved, which is not admissible (PCT Guidelines, Section IV, Chapter III-4.7).



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
 United States Patent and Trademark Office
 Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/048,182	Kurt Berlin	81801
INTERNATIONAL APPLICATION NO.		
PCT/DE00/02595		
I.A. FILING DATE	PRIORITY DATE	
07/27/2000		
CONFIRMATION NO. 2914		
371 FORMALITIES LETTER		
 OC000000007755128		

Date Mailed: 04/03/2002

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Indication of Small Entity Status
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Preliminary Amendments
- Request for Immediate Examination
- Small Entity Statement

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5).

A copy of this notice MUST be returned with the response.

LAMONT M HUNTER

Telephone: (703) 305-3686

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/048,182	PCT/DE00/02595	81801

FORM PCT/DO/EO/905 (371 Formalities Notice)